

REMARKS

Claims 10, 12, 14-21 and 23-40 are pending in the present application. Claims 10, 14 and 37 are independent. Reconsideration of this application in view of the following remarks is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 10, 12, 18, 19, 27-29 and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hashimoto et al., EP 913 465 A1. This rejection is respectfully traversed.

The present invention as recited by independent claim 10 is directed to a device for collecting samples from within a sealed system. Independent claim 10 requires a combination of elements including “a housing,” “an empty receptacle holder” and “a filled receptacle holder.” Furthermore, independent claim 10 requires the recitation “said filled receptacle holder for receiving said at least one receptacle therein and being removably mounted to said housing such that the environment inside said housing and the environment inside said filled receptacle holder remain sealed from each other and the ambient environment outside the housing when said filled receptacle holder and said housing are removed from each other.” With the construction according to independent claim 10 of the present invention, it is possible to supply a receptacle into the inside of the housing to fill the receptacle with the flowable material and remove the receptacle from the inside of the housing into the filled receptacle holder. It is also possible to then remove the filled receptacle holder from the housing with the filled receptacle therein

without contaminating the inside of the housing or the inside of the filled receptacle holder and without contaminating the ambient environment outside the housing. Applicant respectfully submits that the Hashimoto et al. reference relied on by the Examiner fails to teach or suggest the present invention as recited by independent claim 10.

In the Examiner's Office Action, it appears that the Examiner is in agreement with Applicant that the Hashimoto et al. reference fails to disclose the above aspects of the present invention; however, the Examiner has ignored these limitations in the claims on the basis that they are "functional language." Specifically, the Examiner states:

The Examiner would like to point out that the limitation of "when said filled receptacle holder and said housing are removed from each other" is a functional limitation. In claims directed to an apparatus, the manner in which the apparatus operates is insufficient to overcome prior art that teaches the same structural limitations claimed by Applicant. See MPEP 2114. Applicants must incorporate structural limitations into the claims that distinguish the claimed invention from that of the prior art.

Applicant submits that this position by the Examiner is incorrect and requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102 in view of the following comments.

First, the Examiner has stated that the recitation "when said filled receptacle holder and said housing are removed from each other" is a functional limitation. Applicants disagree with this position. Applicants submit that this recitation further defines the structure that is already recited in claim 10. The entire recitation under consideration is "said filled receptacle holder for receiving said at least one receptacle therein and being removably mounted to said housing such that the environment inside said housing and the environment inside said filled receptacle holder

remain sealed from each other and the ambient environment outside the housing when said filled receptacle holder and said housing are removed from each other.” In view of the above, it is the structural recitation of the filled receptacle holder being “removably mounted” that is modified by the recitation “when said filled receptacle holder and said housing are removed from each other.” In other words, the filled receptacle holder is removably mounted “such that [certain conditions exist] when said filled receptacle holder and said housing are removed from each other.” In view of this, the recitation “when said filled receptacle holder and said housing are removed from each other” is not a functional recitation per se, but is a modifier of structure recited in claim 10.

With regard to the structure that the Examiner mentions as being required in claim 10, Applicant submits that the removable mounting in conjunction with the seal that is also recited in claim 10 is sufficient to provide this structure. Specifically, claim 10 recites “said filled receptacle holder being in communication with said ejection port and being sealed with said housing to form a barrier between the environment within the internal cavity of said housing and the ambient environment outside said housing.” In view of this, Applicant submits that all the necessary structure to perform the alleged function of “when said filled receptacle holder and said housing are removed from each other” is included in claim 10. Since Hashimoto et al. does not disclose a seal and a removable mounting that is capable of performing in the same manner as recited in claim 10, Applicant submits that the Examiner’s rejection is improper and should be withdrawn.

Second, to the extent the Examiner still believes that the recitation is functional, the Examiner refers to MPEP 2114 for support for the position that how something operates is insufficient to overcome prior art that teaches the same structural limitations. Applicant submits that the Examiner is misinterpreting the case law that is discussed at MPEP 2114. The case law does not support a position that functional language or how a device is operated cannot be sufficient to define over a prior art reference. What the case law says is that you cannot define a claim in terms of function if a prior art reference discloses all of the structure and is explicitly or inherently capable of performing the function recited in the claim. In the present situation; however, the Hashimoto et al reference is not capable of performing the function recited in claim 10 and therefore the Examiners' position is not consistent with the case law and is therefore improper.

For example, *In re Schreiber* states “[t]he absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference” (emphasis added) *In re Schreiber*, 44 USPQ2d 14291431-32 (Fed. Cir. 1997). In the present situation; however, the Hashimoto et al. reference cannot perform the function recited in claim 10. Furthermore, the claimed function is certainly not inherent in Hashimoto et al. Accordingly, the *In re Schreiber* case does not support the Examiner’s rejection.

The Examiner’s position is also contrary to the basic law of anticipation. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either

explicitly or inherently. See *Glaxo In. V. Novopharm, Ltd.* 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). Since the Hashimoto et al. reference does not disclose the function recited in claim 10 of the present invention, either explicitly or inherently, it cannot anticipate claim 10.

With regard to the other cases discussed at MPEP 2114, if the Examiner were to review these cases, the Examiner would determine that each of these cases involves a situation where a prior art reference discloses all of the structural recitations in the claim and the function recited in the claim is inherent in the reference. In other words, the reference was capable of performing the function. In the present situation; however, the Hashimoto et al. reference is not capable of performing the claimed function and therefore this reference fails to anticipate claim 10 of the present invention.

In the *In re Schreiber* case, the *In re Swinehart* case discussed at MPEP 2114 is also discussed. Specifically, *In re Schreiber* states:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart* (citation omitted) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart* (citation omitted): where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. (emphasis added).

As can be clearly understood from the above, it is necessary for a claimed function to be inherent in a prior art reference before a reference can be considered to anticipate a claim. It is

believed that the Examiner is in agreement with Applicant that the Hashimoto et al. reference does not inherently disclose the function recited in independent claim 10 of the present invention. Accordingly, the Hashimoto et al. reference fails to anticipate independent claim 10.

With regard to dependent claims 12, 18, 19, 27-29 and 35 Applicant respectfully submits that these claims are allowable due to their dependence upon allowable independent claim 10, as well as due to the additional recitations in these claims.

In view of the above amendments and remarks, Applicant respectfully submits that claims 10, 12, 18, 19, 27-29 and 35 clearly define the present invention over the Hashimoto et al. reference relied on by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

Allowable Subject Matter

In the Examiner's Office Action, the Examiner has indicated that claims 14-17, 20, 21, 31-34 and 36-40 are allowed. In addition, dependent claims 23-26 and 30 have been objected to. Applicant greatly appreciates the indication of allowable subject matter by the Examiner.

Since claims 14-17, 20, 21, 31-34 and 36-40 have not been amended, it is believed that these claims should still be in condition for allowance. With regard to claims 23-26 and 30, these claims have not been rewritten in independent form at this time, since it is believed that claim 10 defines the present invention over the prior art relied on by the Examiner.

CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$210.00 is attached hereto.

In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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